

REMARKS:

Claims 23-47, 50-52, 54-59, 73-80, 86-91, 94 and 102-120 were pending in the application. Claims 86-89, 103 and 117 have been canceled. Claims 23-47, 50-52, 54-59, 73-80, 90, 91, 94, 102, 108-116, and 118 have been amended. Therefore, claims 23-47, 50-52, 54-59, 73-80, 90, 91, 94, 102, 104-116, and 118-120 are now pending in this application.

Section 101 Rejections

The Examiner has rejected numerous “computer-readable medium” claims under 35 U.S.C. § 101. The Examiner makes several different assertions, including 1) that there is not a statutory category for the claims, 2) the claims appear to be “software without an embodied tangible medium,” and 3) the “intended use” of the software does not provide a tangible result or embodiment. Applicant responds to each of these points as follows:

Applicant submits that the “computer-readable medium” claims are article of manufacture claims, which is one of the enumerated statutory categories under § 101.

Applicant has previously amended the claims to recite a “tangible computer-readable medium,” which is believed to cure any perceived issue relating to tangibility. The Examiner has objected to this amendment under 35 U.S.C. § 112. This rejection is discussed below. Applicant further submits that the claims are compliant with § 101 even without the addition of the word “tangible.” The Examiner has not, for example, demonstrated by reference to Applicant’s specification (or otherwise) that the use of “computer readable medium” in Applicant’s originally filed claims can be said to cover any “intangible” embodiments. Applicant has further amended the claims to recite a “tangible computer-readable storage medium.”

The Examiner’s statement regarding “intended use” is not understood. It is well known and recognized by the Office that an applicant can direct a claim to an article of manufacture having stored thereon program instructions that, when executed by a computer system, cause the computer system to take certain steps or actions. In this manner, an applicant can cover, for example, an optical medium (e.g., CD-ROM) storing program instruction implementing a software product.

Reconsideration of the § 101 rejection is therefore requested.

Section 112 Rejections

In the Office Action, the Examiner rejected several claims because the word “tangible” is alleged to be “new matter.” Applicant disagrees.

Applicant notes that the originally filed claim set includes claims (17-22) that refer to a “computer program embodied on a computer readable medium.” The specification further discloses that “[t]he present search system 10 is well suited for application in existing and in anticipated future systems employing graphical and other user interfaces” such WebTV, PALM, MP3 players, portable telephones, etc. *See* U.S. Publ. No. 2004/0030675 at ¶ [0088]. *See also id. at* ¶ [0090] (stating that the “search system 10 may be currently implemented in existing and emerging GUIs”). It is well known that computer programs may be stored in computer-readable media within such devices, as well as computer systems such as those shown in Fig. 6. Such computer-readable media are clearly tangible forms of computer-readable storage media. While the specification does not explicitly recite the word “tangible,” one of ordinary skill in the art would certainly recognize that the tangible forms of computer-readable media were in the possession of Applicant at the time of filing. Note that the specification discloses several examples of tangible computer readable storage media that a PC may have (e.g., “removable floppy disk,” “cassette tape media,” “hard drive”). *See* ¶¶ [0003] and [0004].

Section 103 Rejections

The Examiner rejected all pending independent claims under 35 U.S.C. § 103 as being unpatentable over Thompson-Rohrlich, U.S. Patent 5,504,852, in view of Vora et al., U.S. Patent 5,819,273. Applicant respectfully disagrees with these rejections, as set forth below. Applicant has amended several independent claims, however, in order to further prosecution.

Claim 23 has been amended to recite, in part, as follows (emphasis added):

23. A tangible computer readable medium storing instructions that when executed by a computer system connected to a network are capable of causing the computer system to:

define a meta-folder as a type of graphical element, wherein an instantiation of the meta-folder graphical element type is associable with 1) one or more search objects having corresponding search criteria and 2) one or more conventional objects;

display, via a first graphical interface of the computer system, a first graphical representation of a first meta-folder instantiated on the computer system;

upon selection of the first meta-folder via the first graphical interface:

for any search objects associated with the first meta-folder, initiate searching the computer system and the network for conventional objects that satisfy the corresponding search criteria; and

display, via the first graphical interface, graphical elements representing 1) any conventional objects located as a result of the searching and 2) any conventional objects **otherwise** associated with the first meta-folder.

At least the underlined features of claim 23 are not taught or suggested by Thompson-Rohrlich. Consider Fig. 3 of Thompson-Rohrlich that has been cited by the Examiner. This Figure, which is concerned with “displaying the results of a search,” Thompson-Rohrlich, col. 3, line 32, includes a “viewer” folder entitled “Nutshell Mail.” The “Nutshell Mail” folder includes the viewer folders “CHI Info”, “Cars!”, “Donut Hour”, “Ann”, as well as the folder “All Mail.” Applicant submits that each of the folders in the “Nutshell Mail” folder represents objects located as a result of a search. The viewer sub-folders within “Nutshell Mail” (namely, CHI Info, Cars!, Donut Hour, and Ann) are “inner” viewers that are “restricted to files found by the ‘outer’ viewer [Nutshell Mail].” *Id.* at 4: 38-40. *See also id.* at 6:45-48 (“‘If the parent viewer collected, for example, mail, then new Viewers could be created within the Mail Viewer to further sort the mail by subject, addressee, time received, and so forth.’”).

Furthermore, the “All Mail” folder appears to refer to all “Nutshell Mail”—in other words, the results of the search associated with the “Nutshell Mail” folder itself (which has the spectacles icon 30 as shown in Fig. 3). Like the other sub-folders in “Nutshell Mail,” then, the “All Mail” folder appears to be related to search results. The Examiner’s statement that column

3, lines 5-8 supports the notion that the “Nutshell Mail” folder may include “conventional objects associated with a folder not the result of the searching” is thus unsupported. While this passage of Thompson-Rohrlich appears to distinguish between folders with and without the spectacles icon, this passage does not teach or suggest, for example, that the “Nutshell Mail” folder contains any objects not located as a result of a search. Accordingly, Thompson-Rohrlich does not teach suggest “display[ing] ... graphical elements representing 1) any conventional objects located as a result of the searching **and 2) any conventional objects otherwise associated with the first meta-folder.**”

The Examiner suggests that Vora teaches conventional objects being associated with a metafolder. *See* Office Action at 5 (citing column 9, line 64 to column 10, line 3 of Vora). The Examiner’s alleged motivation for this combination was to “refine[] the search criteria” and to “better article the search criteria associated with metafolders.”

Applicant disagrees with these allegations for a number of reasons. First, as Applicant has repeatedly argued, Vora does not teach or suggest a “meta-folder,” as recited in Applicant’s claims. *See* Office Action Response of September 28, 2007 at 20-21 (noting that Vora employs a solution analogous to that described (and criticized) in paragraph [0011] of Applicant’s “Background Art” section). It therefore follows that Vora does not teach or suggest “display[ing] ... graphical elements representing 1) any conventional objects located as a result of the searching and 2) any conventional objects otherwise associated with the first meta-folder,” as recited in claim 23. Second, the portion of Vora cited by the Examiner does not appear to be relevant to the proposition at hand. Finally, the alleged motivation for combining Thompson-Rohrlich and Vora has not been clearly stated, and is thus not believed to rise to the level of establishing a *prima facie* case of obviousness. The Examiner has not stated, for example, how the teachings of Vora would help “refine the search criteria” as alleged, or what such refining would entail.

For at least these reasons, claim 23 is believed to be patentably distinct with respect to the cited references, along with its respective dependent claims. The independent claims 59, 74, 90, 94, 102, and their respective dependent claims are believed to be patentably distinct over the cited references for at least reasons similar to those provided for claim 23.

CONCLUSION:

Applicants submit the application is in condition for allowance, and an early notice to that effect is requested.

If any extension of time (under 37 C.F.R. § 1.136) is necessary to prevent the above-referenced application from becoming abandoned, Applicant hereby petitions for such extension.

The Commissioner is authorized to charge any fees that may be required, or credit any overpayment, to Meyertons, Hood, Kivlin, Kowert & Goetzel, P.C. Deposit Account No. 501505/6057-06101/DMM.

Respectfully submitted,

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